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Name: PATRICIA A. FUNK

Signature: Patricia A. Funk

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of Brunt, et al.	)	Art Unit: 2128
	)	
	)	Examiner: Mussa Shaawat
Serial No. 09/776,260	)	
	)	PAIR Customer No.: 38157
Filed: February 5, 2001	)	
	)	Attorney Docket No.: 50900
For: COLOUR VISUALISATION	)	
SYSTEM	)	Customer Number: 000038157

COMMUNICATION FOR BRIEF ON APPEAL

Mail Stop Appeal Brief – Patents  
Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Accompanying this communication is a Brief on Appeal in support of the Notice of Appeal received at the U.S. Patent and Trademark Office on May 9, 2005, appealing the final rejection of claims 14-30, for which the Appeal Brief is due on or before July 9, 2005. With July 9<sup>th</sup> falling on a Saturday, the time for submission of the Appeal Brief is

extended to Monday, July 11<sup>th</sup>, 2005. The commissioner is hereby authorized to charge deposit account 502800 for any and all fees necessary for filing this brief. A duplicate copy of this communication is included for accounting purposes.

Date: July 11, 2005

Respectfully submitted,

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**BRIEF ON APPEAL**

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Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Brief on Appeal is in support of the Notice of Appeal received at the U.S. Patent and Trademark Office on May 9, 2005, appealing the final rejection of claims 14-30 and Claim 31.

**(1) REAL PARTY IN INTEREST**

The real party in interest is Imperial Chemical Industries PLC a company registered in England with registration number 218019 whose registered office is at 20 Manchester Square, London, W1U 3AN having offices, which is the ultimate parent company of The Glidden Company, a corporation organized and existing under the laws of the State of Delaware, U.S.A., with principal offices at 15885 Sprague Road, Strongsville, Ohio, 44136, U.S.A.

**(2) RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences known to appellants, the appellants' legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board of Patent Appeals and Interferences ("Board")'s decision in the pending appeal.

**(3) STATUS OF CLAIMS**

Originally submitted claims 1-13 were cancelled in an entered amendment under 37 C.F.R. 1.111. This amendment also submitted currently pending claims 14-30, which were rejected in the final office action dated February 4, 2005. The rejection of these claims is on appeal. Claim 31 was submitted in a rule 37 C.F.R. 116 amendment, which was indicated in an Advisory Action dated May 4, 2005 as not placing the application in condition for allowance. Hence claim 31 is also pending and currently on appeal.

**(4) STATUS OF AMENDMENTS**

A final rejection of the above captioned application was mailed February 4, 2005, and an amendment was submitted within two months. This amendment to the final rejection was indicated in the Advisory Action of May 4, 2005 as not placing the application in condition for allowance but nothing was noted regarding any non-entry of the amendment which included Claim 31. Claims 14-30 are those from the amendment in the timely filed Rule 1.111 amendment and are on appeal as well as claim 31 submitted with the rule 116 amendment of April 5, 2005.

## **(5) SUMMARY OF CLAIMED SUBJECT MATTER**

The subject matter of independent claim 14 is directed to one embodiment of the present invention for a method of producing a colour recommendation for a structure or part thereof for painting. This method comprises selecting images of structural archetypes from a database, selecting a colour or colours from a database, applying the colour or colours to the image to produce a colour scheme, and displaying the structure or part thereof with the colour applied and providing information from which paint corresponding to the colour or colours in the scheme can be identified. See page 2 lines 3-12 of the specification. The selecting of an archetype is from the database of archetype images stored in electronic format that closely match the structure to be painted. See page 2 lines 3-12 of the specification. The selecting of the colour or colours is from a database comprising colours stored in electronic format on storage means wherein the colours are grouped by colour names or in groups where the colours are either complementary or contrasting one with another. See page 3 lines 17-19 of the specification.

The subject matter of independent claim 31 is directed to another embodiment of the present invention similar to that of Claim 14 which includes additional features in the selecting of the colour or colours from a database comprising colours stored in electronic format on storage means. Additionally to where the colours are grouped by colour names or in groups where the colours are either complementary or contrasting one with another, the selection by the user involves clicking a mouse button, touching the screen, or using voice activation to pick the colour name or complementary or contrasting colour. See page 4 lines 6-7 of the specification.

The means that is claimed in the pending claims is the storage means, and non-exclusive examples are given at page 3 lines 20-22 and page 4 lines 1-2.

## **(6) Grounds of Rejection to be reviewed on Appeal**

(A) In the office action, claims 14-18 and 20-30 were rejected under 35 U.S.C. 102(e) as being anticipated by the Schuller, et al published patent application U.S. 2001/0047250, hereinafter referred to as Schuller.

(B) Claim 19 was rejected under 35 U.S.C. 103(a) as unpatentable over the Schuller reference. It was noted in the Office Action that the Schuller reference does not include coving and dado rails but it would be obvious to one of ordinary skill in the art to use images of other structural objects.

## **(7) ARGUMENT**

### **(A) Argument against Rejections under 35 USC 102(e) of Claims 14-18 and 20-30 and Claim 31**

#### **i) Standard for Establishing Anticipation**

A claim is anticipated if and only if each and every element as set forth in applicant's claim is found, either expressly or inherently described, in a single prior art reference. (See MPEP 2131). Also an anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). In determining novelty, the first inquiry must be into exactly what the claims define. *In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). "[T]he name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

#### **ii) Appellant's Claims**

Appellant's independent claim 14 describes a method for producing a colour recommendation . . . structure to be painted which comprises . . . selecting a colour or colours from a database comprising colours stored on in electronic format on storage means wherein the colours are grouped by colour names or in groups where the colours are either complementary or contrasting one with another . . . ."

Also Claim 31 describes the selecting of the colour or colours from a database wherein:

“ . . .the colours are grouped by colour names or in groups where the colours are either complementary or contrasting one with another so that a user can select by clicking a mouse button, touching the screen, or using voice activation to pick the colour name or complementary or contrasting colour. . . “.

iii) Rejection of Claim 14 from the final Office Action and Comments in the Advisory Action

The rejection in the Office Action for anticipation was from the teachings of the Schuller reference based on the disclosure at paragraph 39. The Office Action noted Shuller at paragraph 39, lines 1-3, 10-13 selecting colours; paragraph 70, lines 24-30 storage means; 9<sup>th</sup> paragraph, lines 1-6 comparing colours with one another; 28<sup>th</sup> paragraph, figure 60, item 618. This notation was in regards to Applicants' claimed feature of the selection of a colour or colours from a database comprising colours stored on an electronic format on an storage means wherein the colours are grouped by colour names or in groups where the colours are either complementary or contrasting with one another.

It is respectfully submitted that paragraph 39 of the Schuller reference states:

” The interface 600 also includes GUI buttons 613-614 and a colour picker 618 that allow the user to change the decorative material applied to a structural object. The colour picker 618 displays small samples of the different colours that are available for an object and the displayed colours may differ depending on the particular object selected. For example, when a wall structural object 651 is selected, the colour picker 618 may display all available paint colours; when a couch structural object 659 is selected, the colour picker may display all available fabric colours and patterns. When a structural object is

selected, a query 505 may be sent to the web server or directly to the database to retrieve a listing of available colours and/or patterns for a particular object.”

Hence, paragraph 39 does not teach or suggest having the database for the colours where the colours are arranged by anything other than ALL for the particular object. There is no teaching or suggestion of a grouping by colour name or complementary or contrasting colours for selection of a colour.

Additionally, paragraph 70 of Schuller does mention the presence of a storage device for execution by a programmable processor. This does not change the teaching of paragraph 39 to teach or suggest some particular arrangement of colours in a database for selecting a colour.

Also paragraph 9 of Schuller notes:

“The system can include automatic matching of a sample material to a decorative material in the database based on an input image of the sample material. The input image may be obtained using a digital image capture device such as a scanner, digital camera or video signal capture device and the matching decorative materials may be determined by comparing colours, patterns or other visual characteristics associated with the decorative materials and the input image. Identifiers of decorative material samples in a physical sample chart may be displayed to the user.”

This section of the Schuller reference is talking about automatic matching of a sample material to a decorative material so the comparison of the colours, patterns or other visual characteristic data is from the input image to the colours that are available in the database by the computer. This is not a teaching or suggestion of selecting a colour or colours from a database by name or complementary or contrasting colours by a user as is claimed in claim 14. This is particularly the case for added claim 31 which clearly notes the selection by the user by clicking of a mouse button, touching the screen, or using voice activation.

Additionally, the disclosure of Schuller at Figure 6c, reference number 618, the colour picker, does not distinguish on how the colours are selected.



There is no suggestion of any grouping of colours by name or complementary or contrasting colours.

Therefore, it is respectfully submitted that claim 14 and claims dependent therefrom, and added claim 31 are novel and unobvious over the teachings and suggestions of the Schuller reference. Appellant's invention as claimed in independent Claim 14 does not overwhelm the user by providing ALL colours but arranges the colours for the user by name or by complementary or contrasting colour relationship. These features assist the user in making colour choices and provide easy reference for the user to communicate a chosen colour or colours to a source for purchase as claimed in dependent claim 27.

iv) Schuller Reference teaches away from Appellant's Claim 14 and claims dependent therefrom and claim 31.

In addition, the Schuller reference teaches away from any selection of colours by a colour name or on a contrasting or complementary colour basis at paragraph 40 where it notes the monitor, of a computer system, has limitations in the display of colours. Because of this, sample cards can be obtained to see the exact colour. Also, the Schuller reference notes at paragraph 39 beginning at line 6 that for walls as a structural object, the colour picker may display all available paint colours. This teaches away from displaying for selection of colours the colour names or the complementary or contrasting colours. So it is respectfully submitted that Claim 14 and claims dependent therefrom are unobvious and patentable over the Schuller reference.

v) Rejection for Anticipation of Claim 27 Indirectly Dependent from Claim 14

As noted above, Claim 27 is different from the teachings of the Schuller reference since the user can use the colour name or the complementary or contrasting colour relationship to purchase paint from a source.

vi) Rejection for Anticipation of Claims Dependent from Claim 14

The Office Action mentioned that Claims 15-18 and 20-30 were related to the disclosure in the Schuller reference for one reason or another. For all of these dependent claims from Claim 14, it is respectfully submitted that they are novel and patentable for the same reasons as stated above for Claim 14. It is respectfully submitted that since the Schuller reference lacks a teaching or suggestion of the selection by colour name or complementary or contrasting colours as noted above, all of the dependant claims of claim 14 are novel and unobvious over the Schuller reference.

The Advisory Action dated May 4, 2005 noted that Appellant's, as Applicant's, request for reconsideration under 37 C.F.R. 1.111 did not place the application in condition for allowance because:

Applicant argues that Schuller does not teach "the selection of colour or colours from a database . . . are grouped by colour names or in groups where the colours are either complementary or contrasting with one another". Shuller teaches a colour picker that allows the user to change the decorative materials applied to a structural object, the colour picker displays small samples of different colours that are available for an object and the displayed colours may differ depending on the particular object selected [, i.e. the colours are groupe{d} (sic) in groups where the colours are either complementary or contrasting with one another, see [paragraph 39]. In addition Schuller teaches guerying {querying} (sic) the database to retrieve a listing of available colours and/or patterns for a particular object i.e. selection of colour or colours from a database, see [paragraph 39, and Figure 6A block 618]. Therefore Shuller meets the scope of claimed limitation "the selection of colour or colours from a database . . . are grouped by colour names or in groups where the colours are either complementary or contrasting with one another."

Appellant's forgoing arguments apply equally to the statement of the Advisory Action. Paragraph 39 of the Schuller reference is completely

devoid of any mentioning of groups of colour names or groups of complementary or contrasting colours for colour selection. The querying or the database for colour as taught and suggested by the Schuller reference would return colours separated by the type of object (structure or artifact) that is also selected according to the Schuller reference. It is respectfully submitted that this does not teach or suggest grouping colour(s) by names or complementary or contrasting colour relationships.

**(B) Argument against Rejections under 35 USC 103(a) of Claim 19 and Claim 31**

i) The factual inquiries set forth in *Graham v. John Deere Co.* 383 U.S. 1, 148 U.S.P.Q. 459 (1966), establish the background for determining obviousness under 35 U.S.C. § 103. For the first prong of the *Graham* standard, the scope and content of the Schuller reference fails to suggest selecting colours from a database by colour name or complementary or contrasting colour relationship.

Claim 19 was rejected under 35 U.S.C. 103(a) as unpatentable over the Schuller reference. It was noted in the Office Action that the Schuller reference does not include coving and dado rails but it would be obvious to one of ordinary skill in the art to use images of other structural objects.

It is respectfully submitted that the Schuller reference is directed to decorating including furniture and walls in general but not the decoration of the structural elements of a room or building with a colour scheme with or without the presence of room furnishings. Therefore, it is respectfully submitted it would not be obvious from a reading of the Schuller reference that coving and dado rails would be included. Also Claim 19 is dependent from Claim 14 which it is respectfully submitted is unobvious over the Schuller reference so Claim 19 would be also for the same reasons.

For the relationship that coving and dado rails are suggested by general language of images of other structural objects no prior art references are cited. Therefore if the relationship is based upon information that is based on the personal knowledge of the Examiner or someone else within the U.S. Patent and

Trademark Office, it is requested that this be made of record. This can be done in accordance with 37 CFR 1.104(d)(2). Otherwise the current Schuller reference is deficient in suggesting the subject matter of Claim 19.

**(8) CONCLUSION**

In conclusion, the rejection of claims 14-18 and 20-26, 27, and 28-30 and claim 31 under 35 U.S.C.102(e) and any included rejection under 35 U.S.C. 103(a) is improper because the cited reference (Schuller) fails to teach or suggest selecting colour(s) by name or by complementary or contrasting colour relationship. The rejection of claim 19 under 35 U.S.C. 103(a) is further improper because no cited reference or information of record teaches or suggests the coving and dado rails as archetypes. Therefore reversal of these rejections and allowance of the pending claims and captioned application are respectfully requested.

Date: July 11, 2005

Respectfully submitted,

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**APPENDIX**  
**THE CLAIMS ON APPEAL**

14. (Previously submitted) A method for producing a colour recommendation for a structure or part of a structure to be painted which comprises
- a) selecting from a database containing images of structural archetypes stored in electronic format on storage means an archetype image that closely matches the structure to be painted,
  - b) selecting a colour or colours from a database comprising colours stored on in electronic format on storage means wherein the colours are grouped by colour names or in groups where the colours are either complementary or contrasting one with another;
  - c) applying the colour or colours to the image to produce a colour scheme and
  - d) displaying the structure or part of a structure with the colour applied and providing information from which paint corresponding to the colour or colours in the colour scheme can be identified.
15. (Previously submitted) A method according to Claim 14 where the structural archetypes are images of a building.
16. (Previously submitted) A method according to Claim 15 where the image is an interior of a building.
17. (Previously submitted) A method as claimed in Claim 15 where the building is an exterior of a house.

18. (Previously submitted) A method according to Claim 14 where separate areas of the archetypes can be coloured separately one from another.
19. (Previously Submitted) A method according to Claim 18 where the archetype is an interior of a building and the separate areas are walls, doors, coving, ceiling, dado rails, skirting boards, window frames, sills and fireplaces.
20. (Previously Submitted) A method according to Claim 14 where the archetype is an interior of a building and also contains furniture or furnishings.
21. (Previously Submitted) A method according to Claim 20 where colour can be applied separately to the furniture or furnishings.
22. (Previously Submitted) A method according to Claim 14 where the images are photographic quality.
23. (Previously Submitted) A method according to Claim 14 where there is remote access to the database.
24. (Previously Submitted) A method according to Claim 23 where access is via the Internet.
25. (Previously Submitted) A method according to Claim 14 where a user can enter into the method from his point of access, the image to be coloured in electronic form.

26. (Previously Submitted) A method according to Claim 14, which includes printing the colour recommendation for a structure or part of a structure as photographic quality print.
27. (Previously Submitted) A method according to Claim 26, wherein the message includes a source from which the paint can be purchased.
28. (Previously Submitted) A method according to Claim 14, which includes printing the colour recommendation for a structure or part of a structure as a message specifying the colour or colours by an indicator.
29. (Previously Submitted) A method according to Claim 28, wherein the message includes a source from which the paint can be purchased.
30. (Previously Submitted) A method according to Claim 14, wherein the storage means is selected from floppy discs or compact discs.
31. (Previously Submitted) A method for producing a colour recommendation for a structure or part of a structure to be painted which comprises
  - a) selecting from a database containing images of structural archetypes stored in electronic format on storage means an archetype image that closely matches the structure to be painted,
  - e) selecting a colour or colours from a database comprising colours stored on in electronic format on storage means wherein the colours are grouped by colour names or in groups where the colours are either complementary or contrasting one with another so that a user can select by clicking a mouse button, touching the

screen, or using voice activation to pick the colour name or complementary or contrasting colour;

- f) applying the colour or colours to the image to produce a colour scheme, and
- g) displaying the structure or part of a structure with the colour applied and providing information from which paint corresponding to the colour or colours in the colour scheme can be identified.